



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/939,958	08/27/2001	Beth M.P. Delaney	10011325-1	5435

7590 02/28/2005
HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

ZHONG, CHAD

ART UNIT	PAPER NUMBER
----------	--------------

2152

DATE MAILED: 02/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/939,958

Applicant(s)

DELANEY ET AL.

Examiner

Chad Zhong

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 August 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-18 are presented for examination.
2. It is noted that although the present application does contain line numbers in specification and claims, the line numbers in the claims do not correspond to the preferred format. The preferred format is to number each line of every claim, with each claim beginning with line 1. For ease of reference by both the Examiner and Applicant all future correspondence should include the recommended line numbering.
3. Applicant is required to update the status (pending, allowed, etc.) of all parent priority applications in the first line of the specification. The status of all citations of US filed applications in the specification should also be updated where appropriate.
4. The use of the trademark IBM, Apple among others have been noted in this application (pg 3). It should be capitalized wherever it appears and be accompanied by the generic terminology. Appropriate correction is required throughout the entire application.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.
6. Claims 1-2, 4-6, 7-8, 10-12, 13-14, 16-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Hashimoto et al. (hereinafter Hashimoto), US 5,912,697.
7. As per claim 1, Hashimoto teaches a system for extracting an embedded audio file from an image file, comprising:

Art Unit: 2152

a software code segment for extracting an audio file embedded in an image file (Col. 15, lines 19-20);
a memory for storing the extracted audio file (Col. 11, lines 30-45); and
a software code segment for associating the extracted audio file with the image file (Col. 12, lines 9-11, lines 30-51, wherein the audio and video files are re-combinable for future viewing, the association exist for this reason.).

8. As per claim 2, Hashimoto teaches the system of claim 1, wherein the extracted audio file and the image file are attached to an email message (Col. 10, lines 64-67, Col. 11, lines 1-5, lines 42-44, wherein the extracted files are sent via email to the recipient).

9. As per claim 4, Hashimoto teaches the system of claim 1, wherein the image file is compressed (Col. 15, lines 40-50).

10. As per claim 5, Hashimoto teaches the system of claim 1, wherein the software code segment for extracting the embedded audio file analyzes the image file for a marker representing the embedded audio file (Col. 16, lines 61-67, wherein the header information distinguishes the audio data from the video data).

11. As per claim 6, Hashimoto teaches the system of claim 1, wherein the extracted audio file and the image file are separately executable (Col. 27, lines 17-37, wherein video and text data can be executed separately as desired as illustrated in the example, the separate execution of audio and video data would be inherent).

12. As per claims 7-8, 10-12, claims 7-8, 10-12 are rejected for the same reasons as rejection to claim 1-2, 4-6 above respectively.

Art Unit: 2152

14. As per claims 13-14, 16-18, claims 13-14, 16-18 are rejected for the same reasons as rejection to claims 1-2, 4-6 above respectively.

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. Claim 3, 9, 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hashimoto et al. (hereinafter Hashimoto), US 5,912,697, in view of Shinohara et al. (hereinafter Shinohara), US 2002/0046222.

17. As per claim 3, Hashimoto teaches the system of claim 2, wherein the extracted audio file and the image file are represented in the email message by separate items (see for example, Col. 11, lines 30-65, wherein the extracted audio and video files are readily available upon demand from the user's mail box 50).

18. Hashimoto does not explicitly disclose using icons to represent attachments in email messages.

19. Shinohara teaches:
using icons to represent attachments in email message (see for example, Fig 4, item 33), for the advantages of viewing various attachments of the email.

20. It would have been obvious to one of ordinary skill in this art at the time of invention was made to combine the teaching of Hashimoto and Shinohara because they both dealing with updating data extraction techniques. Furthermore, the teaching of Shinohara to allow

Art Unit: 2152

using icons to represent attachments in email messages

would improve the visual capabilities for Hashimoto's system by allowing viewers to have a visual display of the attachments. Furthermore, it would have been obvious Hashimoto's invention would include this aspect, referring to Col. 27, lines 17-36, wherein receiver has the option of choosing the desired data to view, this suggest Hashimoto has the visual means to accomplish this in his invention.

Conclusion

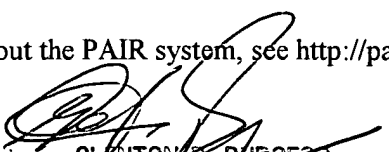
20. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The following patents and publications are cited to further show the state of the art with respect to "SYSTEM FOR EMAILING IMAGES WITH AUDIO AS A SEPARATE FILE".

- i. US 2002/0061136 Shibata et al.
- ii. US 2002/0094193 Tao et al.
- iii. US 2002/0006222 Inagaki et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chad Zhong whose telephone number is (571)272-3946. The examiner can normally be reached on M-F 7:15 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, BURGESS, GLENTON B can be reached on (571)272-3949. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair->


GLENTON B. BURGESS
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100
2/28/08

